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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,646	01/07/2000	BILL J. BONNSTETTER	P03773US1	3342

7590 01/15/2004

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EXAMINER

JEANTY, ROMAIN

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/479,646

Applicant(s)

BONNSTETTER ET AL.

Examiner

Romain Jeanty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 11-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Non-final Office action is in response to the amendment filed on September 29, 2003. By the amendment, claims 15-20 have been withdrawn. No claims were amended nor added. Claims 1-14 are pending in the application.

Response to Arguments

2. Applicants' arguments with respect to claim 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claim 10 is objected to because of the following informalities: Claim 10 does not appear to be properly depended. It appears that claim 10 should depend from claim 9. Appropriate correction is required.

Specification

4. The disclosure is objected to because of the following informalities: Page 9, line 21, "in side" should be -- inside--. Appropriate action is required.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "the set of persons in line 1. There is insufficient antecedent basis for this limitation in the claim or claims on which they depend.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

8. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim1, for a claimed invention to be statutory, the claimed invention must be within the technological arts and provide a concrete tangible result. The claimed invention does not fall within the technological arts because no form of technology is disclosed or claimed. The claimed invention is directed to nothing more than a human making mental computations and manually defining and surveying. Therefore, claim 1 is deemed to be non-statutory. Further, the claimed invention also is not a product for performing a process, nor is it a specific machine or manufacture. The claimed invention is not a specific tangible machine or a process for developing criteria of performance for a job. Claim 1 does not appear to correspond to a specific

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machine or manufacture, and thus encompass any product of the class configured in any manner to perform the underlying process. Furthermore, claim 1 also does not include a post process activity or a pre-computer process activity. Thus, no physical transformation is performed, no practical application in the technological art is found and the claimed invention does not provide a useful tangible result. Consequently, claim1 is analyzed based upon the underlying process, and are thus rejected as being directed to a non-statutory process.

Claims 2-14 depend from independent claim 1; and are rejected similarly.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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10. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated over Barney et al (U.S. 6,070,143).

As per claims 1, 6 and 8, Barney et al discloses a job analysis method comprising:

(a) defining a set of observable behavioral characteristics relevant to a performance in jobs "tasks" (i.e. a database having tasks and personal characteristics for the tasks) (col. 5, lines 34-38-3);

(b) Surveying a set of subject matter experts having knowledge or experience relevant to the job to derive how said characteristics relate to the job (col. 6, lines 40-50);

(c) Defining the job based on said surveying (i.e. define the job based on questionnaire answers from the individual (i.e. determining dimensions that are related to the job) (col. 6, lines 55-60).

As per claims 2, 3, 4 and 5, Barney et al discloses all of the limitations of claim 2, 3, 4 and 5 in the rejection of claim 1 above. In addition, Barney et al discloses wherein the characteristics are related to attitude behaviors (col. 5, lines 50-52). In addition, Barney et al teaches *other personal characteristics*, which implies attitudes and beliefs (col. 6, line 46-50). As per claim 8, Barney et al discloses all of the limitations of claim 8 in the rejection of claim 1 above. In addition, Barney discloses preparing a report based on the surveying (i.e. generating report using the survey results) (col. 1, lines 36-39).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barney et al (U.S. Patent No. 6,070,143) in view of Lautzenheiser et al (U.S. Patent No. US 6,574,621).

As per claim 7, Barney et al discloses Position Analysis Questionnaires and survey idea (col. 1 line 66 through col. 4). But Barney et al does not disclose the questions being pre-correlated to deriving the importance of said characteristics for the particular job. However, pre-correlating the questions to derive the importance of said characteristics. However, Lautzenheiser et al discloses a survey system which correlates questions (col. 10, lines 20-31). It would have been obvious to a person of ordinary skill in the art to modify the disclosures of Barney et al to incorporate the correlation of the survey questions as evidenced by of Lautzenheiser et al. In doing, would provide Barney et al with the enhanced capability determine a response for a particular job.

13. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barney et al (U.S. Patent No. 6,070,143) in view of Hayward et al (U.S. Patent No. 5,574,828).

As per claims 9 and 10, Barney et al fails to explicitly disclose surveying a potential applicant for said job to derive how said characteristics relate to said potential applicant, and surveying a potential applicant for said job to derive how said characteristics relate to said potential applicant and comparing the surveying the surveying of the potential applicant with the

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surveying of the set of subject matter experts. Hayward et al discloses an expert system which surveys a job applicant (col. 5, lines 20-53). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified the teachings of Barney et al to include the teachings of Hayward with the motivation of generating an appropriate response such as a course of action or a qualification decision.

Allowable Subject Matter

14. Claims 11-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached Monday-Thursday from 7:30 am to 6:00 pm. If attempts to reach the examiner are not successful, the examiner's supervisor, Tariq R Hafiz can be reached at (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

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Commissioner for Patents

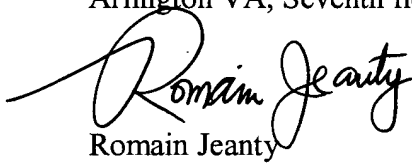
P.O. Box 1450

Alexandria, VA 22313-1450

or faxed to: (703) 305-7687

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,

Arlington VA, Seventh floor receptionist.

A handwritten signature in black ink, reading "Romain Jeanty". The signature is stylized with a large, flowing "R" and a cursive "Jeanty".

Romain Jeanty

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December 12, 2003